UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,886	02/27/2002	Dan Kikinis	007287.00017	7769

22907 7590 11/12/2008

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER	
SCHNURR, JOHN R	

ART UNIT	PAPER NUMBER
2421	

MAIL DATE	DELIVERY MODE
11/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/085,886	KIKINIS, DAN	
	Examiner	Art Unit	
	JOHN R. SCHNURR	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 18-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 18-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Amendment after Non-Final Rejection filed 07/21/2008. Claims 1-12 and 18-21 are pending and have been examined.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. *119(e) or 120* as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/273,102, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Accordingly, claims 1-12 and 18-21 are not entitled to the benefit of the prior application because the newly added limitation of adding a category from a first set to a second set when a plurality of broadcast programs predetermined to be

in the category from the first set are tuned for a period of time at least equal to a first predetermined threshold.

Response to Arguments

3. Applicant's arguments with respect to claims 1-12 and 18-21 have been considered but are moot in view of the new ground(s) of rejection.

Although a new ground of rejection has been used to address limitations that have been added to the claims a response is considered necessary for several of applicant's arguments since reference Schaffer (US 2002/0104087) will continue to be used to meet several claimed limitations.

In response to applicant's argument (Remarks pg. 8 para. 3-5) that the rejection of claims 6 and 12 is improper because "[t]he second set as recited by the claims is not a user profile," the examiner respectfully disagrees. The collection of categories defined by the second set is information which describes user preferences. This is clearly analogous to a profile. Furthermore, applicant describes the second set as a profile in the Remarks dated 02/28/2008, see pg. 7 para. 3.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1, 2, 4-6, 18, and 20 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35

U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims **1, 4, 5, 7, 10, 11 and 18-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McClard (US Patent 6,438,752)** in view of **Wang et al. (US Patent Application Publication 2003/0028871)**, herein Wang, in view of **Knee et al. (US Patent Application Publication 2002/0095676)**, herein Knee and further in view of **Klarfeld et al. (US Patent Application Publication 2003/0067554)**, herein Klarfeld.

Referring to **claim 1**, McClard teaches a method comprising:

> adding a category from a first set of broadcasted programs provided by a media provider **(Head-end server 34 provides**

media and category information, column 4 lines 27-39.) to a second set of categories of broadcasted programs in response to a broadcasted program viewing device being tuned, for a period of time at least equal to a first predetermined threshold, to a broadcasted program predetermined to be in the category from the first set **(Column 4 lines 64-67 and Figure 3 element 54 teaches storing program category information in the memory and Column 5 lines 52-67 and Column 6 lines 1-9 teaches that when a program is watched for a period of time the program is added to a frequency watch list in memory 56 of Figure 3 and along with the program name the type/genre is added to memory 56 thus the category of a program is added from a first set of categories in memory 54 to a second set of data that includes categories in memory 56)**;

However, McClard does not explicitly teach updating the second set in response to a plurality of broadcasted programs being tuned for a period of time at least equal to a first predetermined threshold.

In an analogous art, Wang, which discloses a system for collecting viewing information, clearly teaches updating a second set in response to a plurality of broadcasted programs being tuned for a period of time at least equal to a first predetermined threshold. **(Session time is added to total time and if total time is greater than a predetermined threshold the preference profile is updated, [0034].)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of McClard by updating the second set in response to a plurality of broadcasted programs being tuned for a period of time at least equal to a first predetermined threshold, as taught by Wang, for the benefit of determining channel surfer preferences ([0034] Wang).

McClard further teaches creating multiple profiles. **(column 5 lines 19-41)** McClard combined with Wang fails to teach determining a demographic profile based on the second set; and selecting a first advertisement based on the demographic profile.

In an analogous art, Knee teaches determining a demographic profile based on the second set **(Paragraphs [0029] and [0030] and Figure 2 teach determining demographic categories for a user; Paragraph [0036] teaches that a shows category is used determine a users demographic profile)**; and selecting a first advertisement based on the demographic profile **(Paragraph [0050] teaches determining an advertisement from the user demographic profile)**.

At the time the invention was made it would have been obvious for one skilled in the art to modify the category set moving method McClard combined with Wang using the demographic profiling and advertisement determination method of Knee for the purpose of categorizing user information into demographic categories that could then be used for specified purposes, such as for targeting advertisements or taking certain actions in the program guide (Paragraph [0007], Knee).

However, McClard combined with Wang and Knee does not explicitly teach the plurality of demographic profiles are determined by behavior peaks indicated by the second set.

In an analogous art, Klarfeld, which discloses a system for personalizing television, clearly teaches the different ones of the plurality of demographic profiles are determined by different behavior peaks indicated by the second set. **(Paragraph [0230] and Figure 36 teach determining user profiles based on the observed behavior of the users.)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of McClard combined with Wang and Knee by determining a plurality of demographic profiles by analyzing behavior peaks indicated by the second set, as taught by Klarfeld, for the benefit of simplifying the profile system for the user ([0226] Klarfeld).

Referring to **claim 4**, depending on claim 1, Knee teaches receiving a set of advertisements including the first advertisement **(Paragraph [0023])**.

Referring to **claim 5**, depending on claim 1, Knee teaches removing a category from the second set in response to the broadcast program viewing device not being tuned for a period of time at least equal to a second predetermine threshold, to at least one broadcasting program predetermined to be in the category from the second set **(Paragraph [0044])**.

Referring to **claim 7**, see the rejection of claim 1; **(McClard Figure 3 teaches element 50 a processor and element 52 is memory according to Column 4 lines 54-61; Knee teaches Figure 1 and elements 64 memory and 60 a microprocessor according to Paragraph [0028].)**

Referring to **claim 10**, depending on claim 7, see the rejection of claim 4.

Referring to **claim 11**, depending on claim 7, see the rejection of claim 5.

Referring to **claim 18**, depending on claim 1, Wang teaches adding a category from a first set of broadcasted programs provided by a media provider to a second set of categories of broadcasted programs in response to multiple selectings of at least one broadcasted program predetermined to be in the category from the first set. **([0034])**

Referring to **claim 19**, depending on claim 7, see the rejection of claim 18.

Referring to **claim 20**, depending on claim 1, McClard teaches adding a category from the first set to the second set of categories in response to a selecting of the category from the first set. **(Column 5 lines 52-67 and Column 6 lines 1-9 teaches that when a program is watched for a period of time the program is added to a frequency watch list in memory 56 of Figure 3 and along with the program name the type/genre is added to memory 56 thus the category of a program is added from a first set of categories in memory 54 to a second set of data that includes categories in memory 56 when the category is selected by tuning the program.)**

Referring to **claim 21**, depending on claim 7, see the rejection of claim 20.

6. Claims **2, 3, 8 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McClard (US Patent 6,438,752 B1)** in view of **Wang et al. (US Patent Application Publication 2003/0028871)** in view of **Knee et al. (US Patent Application Publication 2002/0095676)** further in view of **Klarfeld et al. (US Patent Application Publication 2003/0067554)**, as applied to claims 1 and 7 above, and further in view of **Ellis et al. (US Patent Application Publication 2003/0020744)**, herein Ellis.

Referring to **claim 2**, depending on claim 1, McClard, Wang, Knee and Klarfeld fail to teach displaying the first advertisement with an interactive programming guide.

In an analogous art Ellis teaches displaying the first advertisement with an interactive programming guide **(Paragraphs [0125] and [0126] teach selecting an advertisement and Paragraph [0110] teaches using viewer history to determine which advertisements to use in the program guide, Figure 5 elements 108)**.

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of McClard, Wang, Knee and Klarfeld using the targeted advertisement display method of Ellis for the purpose of providing users a user customized program guide experience (Paragraph [0010], Ellis).

Referring to **claim 3**, depending on claim 1, McClard, Wang, Knee and Klarfeld fail to teach transmitting the second set to a unit at a head end of a broadcasting system.

In an analogous art Ellis teaches transmitting the second set to a unit at a head end of a broadcasting system **(Paragraphs [0125] and [0126] and Figure 2b teach transmitting the user history to the program guide server element 25)**.

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of McClard, Wang, Knee and Klarfeld using the transmission of recorded user history data to the head end of Ellis for the purpose of providing users' a user customized program guide experience (Paragraph [0010], Ellis).

Referring to **claim 8**, depending on claim 7, see rejection of claim 2.

Referring to **claim 9**, depending on claim 7, see rejection of claim 3.

7. Claims **6 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McClard (US Patent 6,438,752 B1)** in view of **Wang et al. (US Patent Application Publication 2003/0028871)** in view of **Knee et al. (US Patent Application Publication 2002/0095676)** further in view of **Klarfeld et al. (US Patent Application Publication 2003/0067554)**, as applied to claims 1 and 7 above, and further in view of **Schaffer et al. (US Patent Application Publication 2002/0104087)**, herein Schaffer.

Consider **claim 6**, McClard, Wang, Knee and Klarfeld, combined as in claim1, clearly teach adding a category from a first set to a second set.

However, McClard, Wang, Knee and Klarfeld do not explicitly teach verifying profile updates with a viewer.

In an analogous art, Schaffer, which discloses a system for maintaining a user profile, clearly teaches verifying profile updates with a viewer. **(The feedback request command queries the user about a program being watched, [0048].)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of McClard, Wang, Knee and Klarfeld by verifying profile updates with a viewer, as taught by Schaffer, for the benefit of maximizing the performance of a television recommender ([0010] Schaffer).

Referring to **claim 12**, depending on claim 7, see rejection of claim 6.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN R. SCHNURR whose telephone

number is (571)270-1458. The examiner can normally be reached on Monday - Friday, 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

JRS